



MAIL STOP
AMENDMENT

JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: D.J. Munsil et al. Attorney Docket No.: MSFT118149
Application No.: 10/090,416 Art Unit: 2193 / Confirmation No.: 6209
Filed: March 1, 2002 Examiner: T.J. Roche
Title: CUSTOM APPLICATION-COMPATIBILITY SYSTEMS AND LAYERS

TRANSMITTAL LETTER

Seattle, Washington 98101

September 19, 2006

TO THE COMMISSIONER FOR PATENTS:

Transmittal of Request

Transmitted herewith is a Request for Clarification of 37 C.F.R. § 1.132 Non-Compliant Issues in the above-identified application. This Request includes Exhibits A, B, and C.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}


Gary S. Kindness
Registration No. 22,178
Direct Dial No. 206.695.1702

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first-class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: September 19, 2006 Reedeller Fraser

GSK:aew

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MAIL STOP
AMENDMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: D.J. Munsil et al.

Attorney Docket No.: MSFT118149

Application No.: 10/090,416

Art Unit: 2193 / Confirmation No: 6209

Filed: March 1, 2002

Examiner: T.J. Roche

Title: CUSTOM APPLICATION-COMPATIBILITY SYSTEMS AND LAYERS

REQUEST FOR CLARIFICATION OF 37 C.F.R. § 1.132 NON-COMPLIANT ISSUES

Seattle, Washington 98101

September 19, 2006

Introduction

During a telephone conversation on August 18, 2006, with Examiner Trenton Roche's supervisor (Supervisory Patent Examiner Kakali Chaki), applicants' agent (Hunaid Basrai) was advised that an Advisory Action would be mailed shortly. Applicants' agent and undersigned attorney wish to express their appreciation for the telephone call, which alerted applicants of the need to file an RCE in this application, which has occurred.

During the conversation, applicants' agent was advised that the response to the Final Office Action ("Response") would not be entered, even for purposes of an appeal, since the Response did not place this application in condition for allowance. As best understood by applicants' agent, the 37 C.F.R. § 1.132 Declaration ("132 Declaration") included in the Response After Final failed to overcome the 35 U.S.C. § 102(a) rejections contained in the Final Office Action. Because applicants do not understand the basis for this conclusion, this Request for Clarification is being filed.

Discussion

While the Advisory Action did not state any reasons why the Response did not place this application in condition for allowance, except to note that the Response "failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was

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not presented earlier,"¹ it is applicants' understanding that the 132 Declaration, even when considered in combination with previously submitted 37 C.F.R. § 1.131 Declarations, fails to establish:

- (i) lack of derivation of the claimed invention by the inventors (i.e., the applicants) from the authors of the article that forms the basis for the 35 U.S.C § 102(a) rejection ("Article");
- (ii) that the invention was made by the inventors and not the authors of the Article;
- (iii) how information about the invention was transmitted from the inventors to the authors of the Article; and
- (iv) a correspondence or one-to-one mapping of at least one claim of the present application that corresponds to a screen shot illustrated in the Article.²

Regarding item (i), derivation in a patent sense is: "The act of taking the invention of another person and applying for a patent on the invention. Derivation relates to the question of whether the person who applied for a patent was in fact the person who invented the subject matter claimed in the patent. A person cannot patent an invention derived from another. Only the true inventor or inventors can be the applicants for a patent." *McCarthy's Desk Encyclopedia of Intellectual Property*, 2nd Ed, 1995, p. 114. In this case, one of the authors of the Article (David Morehouse) has clearly stated that neither he nor his co-author (Todd Phillips) is the inventor of the technologies described in the Article. See paragraph 3 of the Declaration by Dave Morehouse ("Morehouse Declaration") attached to the response to the first Office Action in this application, a copy of which is attached as Exhibit A. Since the authors are not the inventors

¹ Applicants do not understand this basis for refusing entry since the 132 Declaration was submitted in response to USPTO inquiries regarding previously submitted Declarations.

² These items are based on applicants' agent's discussion with Supervisor Chaki. No discussion of these types of issues was included in the subsequently received Advisory Action.

of the claimed subject matter, no issue of derivation from the authors exists. If the USPTO disagrees, applicants request a full and complete basis for the disagreement, i.e., the basis for concluding that an issue of derivation exists.

Regarding item (ii), the 132 Declaration signed by all of the applicants, a copy of which is attached hereto as Exhibit B, clearly states that the applicants are the inventors of the invention described and claimed in this application. (See paragraph 1.) The 132 Declaration also states that the Article describes applicants' invention, not an invention of the authors of the article as recognized by the Morehouse Declaration. (See paragraph 5.) Applicants submit that the clear and unequivocal statements by both the inventors and the authors of the Article leave no question regarding who invented the subject matter described in the Article covered by the claims of this application. If the USPTO disagrees, a full and complete discussion of the basis for the disagreement is requested.

Regarding item (iii), applicants direct attention to Items 2 - 4 of the 132 Declaration (Exhibit B), which read as follows:

2. The invention described and claimed in the above-identified patent application was part of the development of a new operating system, namely, the Windows™ XP operating system, developed by our employer--Microsoft Corporation--at the time the invention was made.
3. The development of the Windows™ XP operating system involved a large team of programmers, software developers, program managers, etc., including the authors of articles, such as Dave Morehouse and Todd Phillips, the authors of an article entitled "Windows XP Application Compatibility Technologies" (hereinafter "the article"), which we understand has been cited as prior art in the above-identified patent application.
4. The article, which describes certain aspects of our invention, was prepared for Microsoft by Dave Morehouse and Todd Phillips during the development of the Windows™ XP operating system at the request of the lead program manager, Mark Carroll. We direct attention to the acknowledgment portion of the article (page iii), which recognizes one us, namely, Mark Derbecker as well as Mark Carroll and other program and product managers that we either reported to or worked with at the time we made our invention.

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Applicants submit that the foregoing adequately describes how information about the invention was transmitted from applicants to the authors of the Article. If the USPTO disagrees, applicants request a detailed description of what is required.

During the August 18, 2006, telephone conference, Supervisor Chaki appeared to agree that responses to items (i)-(iii) were present in the previously filed Declaration but were not in a form acceptable to the USPTO. Applicants' agent indicated that he was unaware of any specific form requirements. In response, Supervisor Chaki suggested that applicants' agent review M.P.E.P. for language and form, without identifying any specific section. Applicants' agent has reviewed what he believes to be the pertinent sections of the M.P.E.P., but has been unable to find any exemplary language or form. Thus, applicants request the identification of the specific M.P.E.P. section that contains the exemplary language and form alluded to by Examiner Chaki.

Regarding item (iv), applicants simply do not understand the need for the correspondence or one-to-one mapping of at least one claim of the present application that corresponds to a screen shot illustrated in the Article. It appears that this item may have resulted from statements made in a 37 C.F.R § 1.131 Declaration (attached Exhibit C) by two of the inventors (applicants) attached to the response to the first Office Action filed in this application, namely, paragraphs 6 and 8, which read as follows:

6. The computer code referenced above was used to create screenshots included in an article titled "Windows XP Application Compatibility Technologies," by Dave Morehouse and Todd Phillips, which we understand has been cited as a prior art reference in the above-identified patent application. A copy of this article is attached hereto as Exhibit A.

8. As noted above, the screenshots included in the article titled "Windows XP Application Compatibility Technologies" were created by computer code that was created and used to operate computing devices prior to June 1, 2001, thereby establishing an actual reduction to practice of the invention described and claimed in the above-identified patent application prior to June 1, 2001.

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These statements were intended to aid in establishing that the invention was actually reduced to practice prior to the Article ("...the screen shots included in the article...were created by computer code that was used to operate computing devices prior to June 1, 2001..."). The claims of the present application are directed to methods, computer-readable medium, and computer-controlled apparatus for creating and dynamically applying a custom application-compatibility fix to an application and a related data base, not to screen shots *per se*. As a result, applicants do not understand the need for "...a correspondence or one-to-one mapping..." and request a detailed explanation of this item.

Further Discussion

As noted in this application, the present invention is embodied in the Windows XP operating system developed by the assignee of this application -- Microsoft Corporation ("Microsoft"). As is well known to those familiar with the development of operating systems, the Windows XP operating system was developed by a large team of Microsoft programmers, program managers, product managers, etc. The Windows XP operating system was developed over a long period of time at substantive expense. During the development, various articles describing various features of the Windows XP operating system were generated. Some of the articles were developed by Microsoft for publication, such as the Article cited in the Office Action, i.e., the article titled "Windows XP Application Compatibility Technologies" by Morehouse et al. (The Article bears the Microsoft®Windows®XP Operating System logo.)

As is common in large development efforts, such as the development of the Windows XP operating system, articles are frequently drafted by authors who are not the inventors of the underlying technology. In many instances, the authors do not directly meet with the inventors of technological innovations that underlie the article being prepared. The information may be obtained from a variety of sources such as internal development documents and meetings. In some cases, the inventors are acknowledged in such articles; in other cases, the inventors are not acknowledged. As discussed in the response to the final Office Action and below, the Article

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was created at the request of a program manager identified in the acknowledgements in the Article. The acknowledgements also identify one of the inventors, namely, Mark Derbecker.

The 132 Declaration (Exhibit B), which is signed by all of the applicants/inventors, Donald J. Munsil, Cornelius I. Lupu, Justin Lindsay Steventon (previously Lindsay William Steventon), and Mark Derbecker, declares that they are the inventors of the invention described and claimed in the present patent application. The Declaration states that the invention described and claimed in the present patent application was part of the development of a new operating system, namely, the Windows XP operating system, developed by the inventors' employer, Microsoft Corporation, at the time the invention was made. The Declaration points out that the development of the Windows XP operating system involved a large team of programmers, software developers, program managers, etc. The team also included the authors of articles, such as Dave Morehouse and Todd Phillips, the authors of the Article.

The Declaration further states that the Article, which describes certain aspects of the present invention, was prepared for Microsoft by Dave Morehouse and Todd Phillips during the development of the Windows XP operating system at the request of the lead program manager, Mark Carroll. The Declaration directs attention to the acknowledgment portion of the article (page iii), which recognizes Mark Derbecker, Mark Carroll, and other program and product managers involved in the Windows XP operating system development. The Declaration further states that the Article describes the applicants/inventors' invention, not the invention of the authors of the Article, Dave Morehouse and Todd Phillips, as recognized in a prior Declaration of Dave Morehouse previously filed in this application. In summary, the authors of the Article are simply scribes of technologies invented by others, namely, Donald J. Munsil, Cornelius I. Lupu, Justin Lindsay Steventon, and Mark Derbecker.

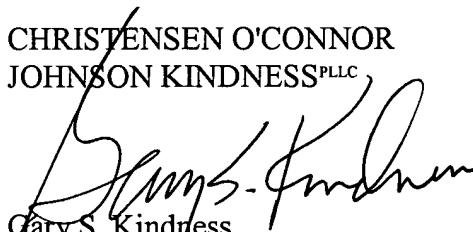
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Conclusion

The claimed subject matter is one portion of a large development, namely, the custom compatibility feature of the Windows XP operating system. The Windows XP operating system development included a large team of Microsoft employees having a wide variety of skills, including management skills, software development skills, article drafting skills, etc. The Article describes applicants' developments, not developments of the authors of the Article. Since the previously provided declarations clearly establish this, applicants submit that the Article is not a valid reference and cannot be used to reject the claims of the present application. Since the Article was the only basis for rejecting the claims in the Office Action, applicants respectfully submit that this application is in condition for allowance. Consequently, early and favorable action allowing this application and passing it to issue is respectfully solicited. As noted above, if the USPTO disagrees, a detailed description of the basis for the disagreement and a full and complete description of what is required to resolve this matter are requested.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}


Gary S. Kindness
Registration No. 22,178
Direct Dial No. 206.695.1702

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first-class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: September 19, 2006
GSK:aew

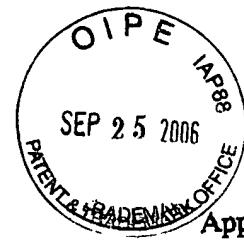


Exhibit A

MAIL STOP
AMENDMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: D.J. Munsil et al.

Attorney Docket No.: MSFT118149

Application No.: 10/090,416

Art Unit: 2193 / Confirmation No: 6209

Filed: March 1, 2002

Examiner: T.J. Roche

Title:

CUSTOM APPLICATION-COMPATIBILITY SYSTEMS AND LAYERS

DECLARATION UNDER 37 C.F.R. § 1.131

Seattle, Washington 98101

October 18, 2005

TO THE COMMISSIONER FOR PATENTS:

I, David Morehouse, declare:

1. I am one of the authors identified in an article titled "Windows XP Application Compatibility Technologies" by Dave Morehouse and Todd Phillips, published June 1, 2001, a copy of which is attached hereto as Exhibit A.
2. The article titled "Windows XP Application Compatibility Technologies," which was prepared as part of my employment duties at Microsoft Corporation, describes technologies disclosed to me by others at Microsoft Corporation.
3. The technologies described in the article titled "Windows XP Application Compatibility Technologies" were not invented by me or Todd Phillips.
4. At the time the article titled "Windows XP Application Compatibility Technologies" was prepared by me and Todd Phillips, the technology described in the article, namely Windows XP application compatibility technology, was included in test versions of the Windows XP operating system being developed by Microsoft Corporation as evidenced by the screenshots included in the article, which were obtained from computing devices running test versions of the Windows XP operating system.

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5. That all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of United States Code, and that such willful false statements may jeopardize the validity of this application or any patent that issues thereon.

Date: 10/18/2005

David Morehouse

David Morehouse

GSK:aww

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Exhibit B

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RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2100



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: D.J. Munsil et al.

Attorney Docket No.: MSFT118149

Application No.: 10/090,416

Art Unit: 2193 / Confirmation No: 6209

Filed: March 1, 2002

Examiner: T.J. Roche

Title: CUSTOM APPLICATION-COMPATIBILITY SYSTEMS AND LAYERS

DECLARATION UNDER 37 C.F.R. § 1.132

Seattle, Washington 98101

June 22, 2006

TO THE COMMISSIONER FOR PATENTS:

We, Donald J. Munsil, Corneliu I. Lupu, Justin Lindsay Steventon (previously Lindsay William Steventon), and Mark Derbecker, declare:

1. We are the inventors of the invention described and claimed in the above-identified patent application.

2. The invention described and claimed in the above-identified patent application was part of the development of a new operating system, namely, the Windows™ XP operating system, developed by our employer--Microsoft Corporation--at the time the invention was made.

3. The development of the Windows™ XP operating system involved a large team of programmers, software developers, program managers, etc., including the authors of articles, such as Dave Morehouse and Todd Phillips, the authors of an article entitled "Windows XP Application Compatibility Technologies" (hereinafter "the article"), which we understand has been cited as prior art in the above-identified patent application.

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4. The article, which describes certain aspects of our invention, was prepared for Microsoft by Dave Morehouse and Todd Phillips during the development of the Windows™ XP operating system at the request of the lead program manager, Mark Carroll. We direct attention to the acknowledgment portion of the article (page iii), which recognizes one us, namely, Mark Derbecker as well as Mark Carroll and other program and product managers that we either reported to or worked with at the time we made our invention.

5. The article describes our invention, not the invention of the authors of the article, Dave Morehouse and Todd Phillips, as recognized in a declaration by Dave Morehouse previously filed in this application.

6. Computer code for carrying out our invention was used to create the screenshots included in the article.

7. All statements made herein of our own knowledge are true and all statements made on information and belief are believed to be true. Further, these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and such willful false statements may jeopardize the validity of this application or any patent that issues thereon.

Date: _____

Donald J. Munsil

Date: _____

Corneliu I. Lupu

4. The article, which describes certain aspects of our invention, was prepared for Microsoft by Dave Morehouse and Todd Phillips during the development of the Windows™ XP operating system at the request of the lead program manager, Mark Carroll. We direct attention to the acknowledgment portion of the article (page iii), which recognizes one us, namely, Mark Derbecker as well as Mark Carroll and other program and product managers that we either reported to or worked with at the time we made our invention.

5. The article describes our invention, not the invention of the authors of the article, Dave Morehouse and Todd Phillips, as recognized in a declaration by Dave Morehouse previously filed in this application.

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Date: 6-23-2006


Donald J. Munsil

Date: _____

Cornelius I. Lupu

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4. The article, which describes certain aspects of our invention, was prepared for Microsoft by Dave Morehouse and Todd Phillips during the development of the Windows™ XP operating system at the request of the lead program manager, Mark Carroll. We direct attention to the acknowledgment portion of the article (page iii), which recognizes one us, namely, Mark Derbecker as well as Mark Carroll and other program and product managers that we either reported to or worked with at the time we made our invention.

5. The article describes our invention, not the invention of the authors of the article, Dave Morehouse and Todd Phillips, as recognized in a declaration by Dave Morehouse previously filed in this application.

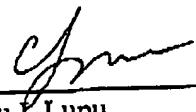
6. Computer code for carrying out our invention was used to create the screenshots included in the article.

7. All statements made herein of our own knowledge are true and all statements made on information and belief are believed to be true. Further, these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and such willful false statements may jeopardize the validity of this application or any patent that issues thereon.

Date: _____

Donald J. Munsil

Date: 6/23/06


Corneliu I. Lupu

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Date: 22 JUNE 2006


Mark Derbecker

Date: _____

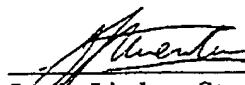
Justin Lindsay Steventon
(previously Lindsay William Steventon)

GSK:nfs

Date: _____

Mark Derbecker

Date: 06/22/2006


Justin Lindsay Steventon
(previously Lindsay William Steventon)

GSK:nfs

-3 of 3-

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Exhibit C

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AMENDMENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: D.J. Munsil et al.

Attorney Docket No.: MSFT118149

Application No.: 10/090,416

Art Unit: 2193 / Confirmation No: 6209

Filed: March 1, 2002

Examiner: T.J. Roche

Title:

CUSTOM APPLICATION-COMPATIBILITY SYSTEMS AND LAYERS

DECLARATION UNDER 37 C.F.R. § 1.131

Seattle, Washington 98101

October 19, 2005

TO THE COMMISSIONER FOR PATENTS:

We, Donald J. Munsil and Corneliu I. Lupu, declare:

1. We are two of the inventors of the invention described and claimed in the above-identified patent application.

2. The invention described and claimed in the above-identified patent application was actually reduced to practice prior to June 1, 2001.

3. Specifically, computer code for carrying out the invention described and claimed in the above-identified patent application was created and used to operate computer devices prior to June 1, 2001.

4. More specifically, the invention described and claimed in the above-identified application was developed for inclusion in the Windows XP operating system developed by our employer, Microsoft Corporation, the assignee of the above-identified patent application.

5. Computer code for carrying out the invention described and claimed in the above-identified patent application was included in versions of the Windows XP operating system in existence prior to June 1, 2001.

6. The computer code referenced above was used to create screenshots included in an article titled "Windows XP Application Compatibility Technologies," by Dave Morehouse

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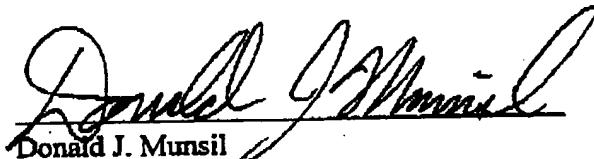
and Todd Phillips, which we understand has been cited as a prior art reference in the above-identified patent application. A copy of this article is attached hereto as Exhibit A.

7. The article titled "Windows XP Application Compatibility Technologies," by Dave Morehouse and Todd Phillips, which describes certain aspects of the invention described and claimed in the above-identified patent application, was prepared for our employer, Microsoft Corporation, the assignee of the above-identified patent application.

8. As noted above, the screenshots included in the article titled "Windows XP Application Compatibility Technologies" were created by computer code that was created and used to operate computing devices prior to June 1, 2001, thereby establishing an actual reduction to practice of the invention described and claimed in the above-identified patent application prior to June 1, 2001.

9. That all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of United States Code, and that such willful false statements may jeopardize the validity of this application or any patent that issues thereon.

Date: 10/20/05


Donald J. Munsil

Date: 10/19/05


Cornelius I. Lupu

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